

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Rodrigo CHUAQUI et al.

Appl. No. 09/743,825

Confirmation No. 8611

Filed: January 15, 2002

For: PB39, A GENE DYSREGULATED
IN PROSTATE CANCER, AND
USES THEREOF

Art Unit: 1642

Examiner: Minh-Tam DAVIS

Atty. Docket No. 31978-202420

Customer No.

45323

PATENT TRADEMARK OFFICE

REQUEST TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.48(a)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.48(a), Applicant hereby requests correction of the inventorship of this application.

The desired inventorship change is the addition of Michael R. Emmert-Buck as an additional inventors on the application.

Filed herewith are the following:

- (1) An Inventor Statement Under 37 C.F.R. § 1.48(a) made by the added inventor, Michael R. Emmert-Buck who states that the error in inventorship occurred without deceptive intention on his part;
- (2) A new Declaration/Power of Attorney executed by all of the named inventors;
and
- (3) The processing fee of \$130.

If a check is not enclosed or if a greater or lesser fee is required, please charge or credit

deposit account number 22-0261 accordingly and notify the undersigned.

Respectfully submitted,

Date: November 9, 2004

Nancy Axelrod

Nancy J. Axelrod, Patent Agent

Registration No. 44,014

VENABLE LLP

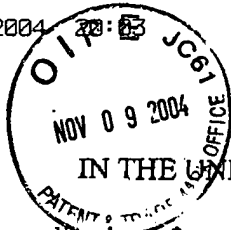
P.O. Box 34385

Washington, D.C. 20043-9998

Telephone: (202) 344-4000

Telefax: (202) 344-8300

::ODMA\PCDOCS\DC2DOCS1\594145\1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

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Art Unit: 1642

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Atty. Docket No. 31978-202420

Customer No.

45323

PATENT TRADEMARK OFFICE

STATEMENT OF ADDED INVENTOR UNDER 37 C.F.R. § 1.48(a)

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

An error in inventorship occurred with this application, namely the omission of Michael R. Emmert-Buck as a named inventor. This error in inventorship occurred without deceptive intention on my part. Accordingly, please amend the application to include me as an inventor.

Date: 11/8/04


Michael R. Emmert-Buck

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL
for FY 2005

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 130**Complete if Known**

Application Number	09/743,825
Filing Date	January 15, 2002
First Named Inventor	Rodrigo CHUAQUI et al.
Examiner Name	Minh-Tam DAVIS
Group / Art Unit	1642
Attorney Docket No.	31978-202420

METHOD OF PAYMENT (check one)

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit
Account
Number

22-0261

Deposit
Account
Name

Venable LLP

- ☒
- Charge Any Additional Fee Required
-
- Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status.
See 37 CFR 1.27

- 2.
- ☒
- Payment Enclosed:

☐ Check ☐ Credit card ☐ Money
Order ☒ Other
Deposit Account**FEE CALCULATION**

1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1)

(\$ 0)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	** = 0	X	= 0
Multiple Dependent	X		= 0

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	88	2201	44	Independent claims in excess of 3
1203	300	2204	150	Multiple dependent claim, if not paid
1204	88	2204	44	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$ 0)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2215	55	Extension for reply within first month	
1252	430	2252	215	Extension for reply within second month	
1253	980	2253	490	Extension for reply within third month	
1254	1,530	2254	765	Extension for reply within fourth month	
1255	2080	2255	1040	Extension for reply within fifth month	
1401	340	2401	170	Notice of Appeal	
1402	340	2402	170	Filing a brief in support of an appeal	
1403	300	2403	150	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,370	2453	685	Petition to revive - unintentional	
1501	1,370	2501	685	Utility issue fee (or reissue)	
1502	490	2502	245	Design issue fee	
1503	660	25403	330	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	130.00
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1808	130	1808	130	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

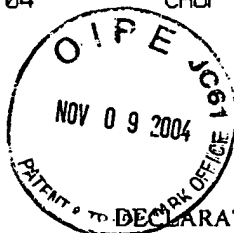
(\$ 130)

SUBMITTED BY**Complete (if applicable)**

Name (Print/Type)	Nancy J. Axelrod	Registration No. Attorney/Agent)	44,014	Telephone	(202) 344-4000
Signature	Nancy Axelrod			Date	November 9, 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.
SEND TO: Commissioner for Patents, Mail Stop Patent Application, Alexandria, VA 22313-1450.**VENABLE**
ATTORNEYS AT LAW

PC Docs No. ::ODMAIPDCSDC2DOCS15960101

Attorney Docket 31978-202420

DECLARATION FOR UNITED STATES PATENT APPLICATION

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name, and that I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled **PB39, A GENE DYSREGULATED IN PROSTATE CANCER AND USES THEREOF**, the specification of which

[] is attached hereto.

[] was filed on _____ as Application Serial No. _____, and was amended on _____ [if applicable].

[X] was filed under the Patent Cooperation Treaty on July 23, 1999 Serial No. PCT/US99/16831 the United States of America being designated, and was amended on February 3, 2004, and was amended and to be filed on November 5, 2004. The serial number of the U.S. National Stage application is 09/743,825, filed on January 15, 2002.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, 1.56.

I HEREBY CLAIM foreign priority benefits under Title 35, United States Code §119(a)-(d) of §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below any foreign application for patent or inventor's certificate or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number	Country	Foreign Filing Date	Priority Claimed

I HEREBY CLAIM the benefit under Title 35, United States Code §119(c) of any United States provisional application(s) listed below.

U.S. Provisional Application Number	Filing Date
60/094,137	July 24, 1998

I HEREBY CLAIM the benefit under Title 35, United States Code, §120 of any United States application(s), or §365(c) of any PCT International application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

U.S. Patent Application Number	PCT Patent Application Number	Patent Filing Date	Parent Patent Number

Attorney Docket: 31978-202420

I hereby appoint the registered attorneys and agents of the National Institutes of Health, Office of Technology Transfer, and VENABLE LLP associated with the following customer number to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

45323

PATENT TRADEMARK OFFICE

VENABLE is located at 575 7th Street, N.W., Washington, D.C. 20004-1601, Telephone: (202) 344-4000, Telefax: (202) 344-8300. Address all correspondence to VENABLE, Post Office Box 34385, Washington, D.C. 20043-9998.

The undersigned hereby authorizes the registered U.S. attorneys and agents identified herein to accept and follow instructions from the undersigned's assignee, if any, and/or, if the undersigned is not a resident of the United States, the undersigned's domestic attorney, patent attorney or patent agent, as to any action to be taken in the Patent and Trademark Office regarding this application without direct communication between U.S. attorneys and the undersigned. In the event of a change in the person(s) from whom instructions may be taken, the registered U.S. attorneys and agents identified herein will be so notified by the undersigned.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signature: _____ Date: _____
2004.

First/Joint Inventor: Rodrigo F. CHUAQUI, MD
Citizenship: Chilean
Residence and Post Office Address: 10630 Montrose Avenue, Apt. 203
Bethesda, Maryland 20814

Signature: _____ Date: _____
2004.

Second Inventor: Kristina A. COLE, MD, Ph.D.
Citizenship: United States of America
Residence and Post Office Address: 303 Park Ave.
Swarthmore, Pennsylvania 19081

Signature: Lance Liotta Date: 11-5-04
2004.

Third Inventor: Lance A. LIOTTA, MD, Ph.D.
Citizenship: United States of America
Residence and Post Office Address: 8601 Bradley Boulevard
Bethesda, Maryland 20817

Attorney Docket: 31978-202420

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Signature: _____
2004.Date: 11-4-04

First/Joint Inventor: Rodrigo F. CHUAQUI, MD

Citizenship: Chilean

Residence and Post Office Address: 10630 Montrose Avenue, Apt. 203
Bethesda, Maryland 2081412633 Falconbridge Drive,
North Potomac, Maryland 20878R.C.
11-4-04Signature: _____
2004.

Date: _____

Second Inventor: Kristina A. COLE, MD, Ph.D.

Citizenship: United States of America

Residence and Post Office Address: 303 Park Ave.
Swarthmore, Pennsylvania 19081Signature: _____
2004.

Date: _____

Third Inventor: Lance A. LIOTTA, MD, Ph.D.

Citizenship: United States of America

Residence and Post Office Address: 8601 Bradley Boulevard
Bethesda, Maryland 20817

Attorney Docket: 31978-202420

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Signature: _____ Date: _____, 2004.

First/Joint Inventor: Rodrigo F. CHUAQUI, MD

Citizenship: Chilean

Residence and Post Office Address: 10630 Montrose Avenue, Apt. 203
Bethesda, Maryland 20814

Signature:  _____ Date: 4/5/04 2004.

Second Inventor: Kristina A. COLE, MD, Ph.D.

Citizenship: United States of America

Residence and Post Office Address: 303 Park Ave.
Swarthmore, Pennsylvania 19081

Signature: _____ Date: _____, 2004.

Third Inventor: Lance A. LIOTTA, MD, Ph.D.

Citizenship: United States of America

Residence and Post Office Address: 8601 Bradley Boulevard
Bethesda, Maryland 20817

Attorney Docket: 31978-202420Signature:
2004.Date: 11/8/04

Fourth Inventor: Michael R. EMMERT-BUCK, MD, Ph.D.
Citizenship: United States of America
Residence and Post Office Address: 110 Stewart Street
Easton, Maryland 21601

::ODMA\PCDOCS\DC2DOCS\1594127\I



Application Data Sheet

Application Information

Application Type::	Regular
Subject Matter::	Utility
Suggested Group Art Unit::	1642
CD-ROM or CD-R?::	None
Sequence submission?::	None
Computer Readable Form (CRF)?::	No
Title::	PB39, A GENE DYSREGULATED IN PROSTATE CANCER, AND USES THEREOF
Attorney Docket Number::	31978-202420
Request for Early Publication?::	No
Request for Non-Publication?::	No
Small Entity?::	No
Petition included?::	No
Secrecy Order in Parent Appl.?::	No

Applicant Information

Applicant Authority Type::	Inventor
Primary Citizenship Country::	Chile
Status::	Full Capacity
Given Name::	Rodrigo
Middle Name::	F.
Family Name::	CHUAQUI
City of Residence::	Bethesda
State or Province of Residence::	MD
Country of Residence::	US
Street of mailing address::	12633 Falconbridge Drive
City of mailing address::	North Potomac

State or Province of mailing address:: MD
Postal or Zip Code of mailing address:: 20878

Applicant Authority Type:: Inventor
Primary Citizenship Country:: United States
Status:: Full Capacity
Given Name:: Kristina
Middle Name:: A.
Family Name:: COLE
City of Residence:: Swarthmore
State or Province of Residence:: PA
Country of Residence:: US
Street of mailing address:: 6011 Executive Boulevard
Suite 325
City of mailing address:: Rockville
State or Province of mailing address:: MD
Postal or Zip Code of mailing address:: 20852

Applicant Authority Type:: Inventor
Primary Citizenship Country:: United States
Status:: Full Capacity
Given Name:: Lance
Middle Name:: A.
Family Name:: LIOTTA
City of Residence:: Bethesda
State or Province of Residence:: MD
Country of Residence:: US
Street of mailing address:: 8601 Bradley Boulevard
City of mailing address:: Bethesda
State or Province of mailing address:: MD

Postal or Zip Code of mailing address:: 20817

Applicant Authority Type:: Inventor
Primary Citizenship Country:: United States
Status:: Full Capacity
Given Name:: Michael
Middle Name:: R.
Family Name:: EMMERT-BUCK
City of Residence:: Easton
State or Province of Residence:: MD
Country of Residence:: US
Street of mailing address:: 110 Stewart Street
City of mailing address:: Easton
State or Province of mailing address:: MD
Postal or Zip Code of mailing address:: 21601

Correspondence Information

Correspondence Customer Number:: 45323

Representative Information

Representative Customer Number:: 45323

Domestic Priority Information

Application::	Continuity Type::	Parent Application::	Parent Filing Date::
60/094,137			July 24, 1998

Assignee Information

Assignee name:: United States of America, as represented by
the Secretary of the Department of Health
and Human Services c/o National Institutes
of Health

Street of mailing address:: 6011 Executive Boulevard, Suite 325

City of mailing address:: Rockville

State or Province of mailing address:: Maryland

Postal or Zip Code of mailing address:: 20852-3804

::ODMA\PCDOCS\DC2DOCS1\596052\1